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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/873,259

06/05/2001

Teruo Tanaka

NIT-278

5965

24956

7590

07/03/2006

MATTINGLY, STANGER, MALUR & BRUNDIDGE, P.C.  
1800 DIAGONAL ROAD  
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ALEXANDRIA, VA 22314

EXAMINER

CHENCINSKI, SIEGFRIED E

ART UNIT

PAPER NUMBER

3628

DATE MAILED: 07/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	09/873,259	TANAKA ET AL.	
	Examiner	Art Unit	
	Siegfried E. Chencinski	3628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 05 June 2001.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>09/05/01</u> .  | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

1. **Claims 1-12 are rejected** because the claimed invention is directed to non-statutory subject matter. Claims 1-12 are not directed to any one of the areas of patentable subject matter, such as product, process, process of making or composition. For a claim to be statutory under 35 USC 101 the following two conditions must be met:

1) In the claim, the practical application of an algorithm or idea results in a useful, concrete, tangible result,

AND

2) The claim provides a limitation in the technological arts that enables a useful, concrete, tangible result.

According to the above guidelines, Applicant's claims are limited to the manipulation of abstract ideas in the context of patentability.

**Claims 1-12** are rejected under 35 U.S.C. 101 because the claimed invention is not supported by either a clearly asserted utility or a well established utility.

The specification and the direct transfer of specification language into the claims as limitations is apparently caused by the poor translation of this application of the entire disclosure, perhaps by a language translation software program. The translation seems literate from the Japanese and fails to follow English rules and guidelines of word usage and grammar. This causes serious ambiguity which makes the invention difficult to comprehend for the ordinary practitioner. These comprehension difficulties, which have really comprehension barriers, are the result of unusual word usage, such as he

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expression "computing environment" and communication between such "computing environment"(s), unusual, non-English grammar and other non standard use of English terminology in the context of business methods and computer systems. Further, the expression "computing environment" is only found in claims 5, 6 and 7, and is not found in the specification. This expression is not used in this context in the English language used and understood by the ordinary practioner at the time of applicant's invention, or since then.

To further explain, the meaning and function of the term "computing environment" in claims 5, 6 and 7 is difficult to understand because

1. The expression is not found in the specification,
2. It is not commonly used in this context
3. The Microsoft Computer Dictionary does not offer a definition for this expression.

The closest definition in the Microsoft Press Computer Dictionary gives two definitions for "environment" which do not suggest a computer network address which the context of the claimed limitations seems to require .

Another example of unusual word usage is the owrd "side". Aat first the examiner thought that this was a misspelling of the word "site" which would be appropriate in the context of computer network communications, such as the expression "web site".

Further review made the examiner realize that the intended meaning is the word "side" as on one side or another side. All in all, the awkward language resulted in the examiner spending double the hours in this first step of prosecution than would have been required of more normal English language and grammar had been used in the disclosure of this application.

**2. Claims 1-12** are also rejected under 35 U.S.C. 112, first paragraph. Specifically, since the claimed invention is not supported by either a clearly asserted utility or a well established utility for the reasons set forth above, one skilled in the art clearly would not know how to use the claimed invention.

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Applicant is advised to satisfy the statutory requirements for the claims. Applicant is also advised not to add any new matter to the specification or the claims.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

**3. Claim 1-12 are rejected under 35 U.S.C. 112, first paragraph,** as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The claimed invention lacks patentable utility because the unusual and difficult to understand terminology would prevent the ordinary practitioner from being to understand Applicant' invention for the purpose of putting the invention to practical use.

**4. Claim 1-12 are rejected under 35 U.S.C. 112, first paragraph,** as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The claimed invention fails to comply with the enablement requirement because the unusual and difficult to understand terminology would prevent the ordinary practitioner from being to understand Applicant' invention for the purpose of putting the invention to practical use.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

**5. Claim 1-12 are rejected under 35 U.S.C. 112, second paragraph,** as being indefinite for failing to particularly point out and distinctly claim the subject matter which

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applicant regards as the invention. This is caused by the unusual and difficult to understand terminology would prevent the ordinary practitioner from being to understand Applicant' invention for the purpose of putting the invention to practical use.

**6. Claims 5, 6 and 7 recite variations of the limitation “communicating with the computing environment”. There is insufficient antecedent basis for this limitation in the claim. The expression “computing environment” is not contained in the specification.**

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**7. Claims 1-4 are rejected** under 35 U.S.C. 103(a) as being unpatentable over Huberman (US Patent 5,826,244) in view of Koopersmith (US Pregrant Publication 2001/0042002 A1).

**Re. Claim 1,** Huberman discloses a method for an auction brokerage service provided by a computer that resides between an information terminal of a user and auction servers to perform brokerage operation for an auction. Huberman also discloses a computer automated third party broker service for administering an auction process between sellers and prospective customers (Abstract, Il. 1-2). Huberman further discloses multiple auctions (Col. 7, Il. 12-15; Col. 18, Il. 38-41) and communicating with the customer's user information terminal to notify of the auction result information (Col. 3, l. 59 – Col. 4, l. 18).

Huberman does not explicitly disclose a method for:

- communicating with the customer's user information terminal to locate auction servers suitable for the user's requirement;

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- communicating with the auction servers that have been selected by the user from among the located auction servers to receive notification confirming that an auctioned commodity of the user has been registered at the auction servers;
- communicating with the selected auction servers to receive auction result information.

However, third party services involving computer automation were well known at the time of applicant's invention. Huberman discloses such a service. A well known computer automated third party service provider is eBay®, which operates an auction market for buyers and sellers of a wide variety of products and services. Historically well known is participation in multiple auction markets by sellers. For example, many commodities are simultaneously registered and offered for sale in a plurality of auction markets, both nationally in the USA as well as globally. Such commodities include financial securities such as publicly traded common stocks (Examples are in the US - New York Stock Exchange, American Stock Exchange, NASDAQ, Philadelphia Stock Exchange, Pacific Stock Exchange, OTC (Over the Counter); outside the US – Stock exchanges in London, Paris, Frankfurt, Tokyo, Kong Kong, and more. Stocks are listed on a plurality of stock exchanges for a variety of reasons related to how the company prefers to manage the market for its security). Commodities such as oil and oil derivatives such as gasoline, jet fuel and certain plastic resins, agricultural commodities such as wheat, corn, soy beans, sugar, coffee and cocoa, metals such as gold, silver and copper are traded on a plurality of exchanges and have had their contracts listed on multiple exchanges – e.g. Chicago Board of Trade, Chicago Mercantile Exchange, the New York Mercantile Exchange and exchanges located in major trading centers around the world, such as London, Paris and Tokyo. Each of these auction markets has been in operation for generations, even for over a century. Each was offering its services online through computer automation at the time of Applicant's invention. It was well known at the time of Applicant's invention that the computer systems of these auction exchanges provide the various communications responses such as the confirmation of commodity registration offered for sale and to provide auction result information.

Further, locating servers which offer certain information or services was also well known at the time of Applicant's invention. For example, at the time of applicant's invention a rapidly growing information search facility service industry by such companies as Google ® have made search for service provider servers such as those of auction services quite simple. For example, Koopersmith discloses a search server searching a data base of web site addresses for web sites fitting a certain word definition. Such a search is likely to bring up a number of qualified web sites, which are essentially contained in a server. Koopersmith's example illustrates a search for suppliers of toasters (page 1, [0004]-II. 8-16). It would have been obvious to the practitioner that a similar automated search would have located servers which offer commodity auction servers which meet the seller's commodity criteria. He disclosures by Huberman and Koopersmith, combined with the well known practices would hence have made it obvious to the ordinary practitioner to

- conduct on line communications with the customer user and the internet to locate auction servers suitable for the user's requirement;
- communicate with the auction servers that have been selected by the user from among the located auction servers to receive notification confirming that an auctioned commodity of the user has been registered at the auction servers;
- communicate with the selected auction servers to receive auction result information.

Therefore, it would have been obvious to an ordinary practitioner at the time of Applicant's invention to have combined the disclosures of Huberman with the disclosures of Koopersmith and with the incorporation of the above mentioned well known practices for the purpose of providing computer automated third party multi auction brokerage services for a client through a computer link, motivated by an opportunity to establish better prices for the sale of commodities through a more efficient auction process through electronically networked, highly automated, brokered auctions (Huberman, Col. 2, II. 50-51, 55-56).

**Re. Claim 2,** Huberman discloses a method for auction brokerage service further



comprising a step of monitoring trading status at said plurality of auction servers and communicating with relevant auction servers to notify the other auction sites of the highest tendered price among all tendered prices. Applicant has chosen to define the notification step in the specification as meaning the option of "Specifically, the auction site monitoring section 242 may place .... Or it may alter the lower limit of the desired price of such commodity into the highest tendered price in the name of the user" (Specification, page 15, ll. 13-23). The option of changing an offer price such as the minimum acceptable price in an auction was well known at the time of Applicant's invention. This well know and well established practice not only a basis as an old practice prior to the consummation of a transaction, but it is also embedded in US law. An offer may be changed or withdrawn at any time before it is legally accepted. Therefore, it would have been obvious to an ordinary practitioner at the time of Applicant's invention to have combined the disclosures of Huberman with the disclosures of Koopersmith and with the incorporation of the above mentioned well known practices for the purpose of monitoring trading status at said plurality of auction servers and communicating with relevant auction servers to notify the other auction sites of the highest tendered price among all tendered prices, motivated by an opportunity to establish better prices for the sale of commodities through a more efficient auction process through electronically networked, highly automated, brokered auctions (Huberman, Col. 2, ll. 50-51, 55-56).

**Re. Claim 3,** Huberman discloses a method for auction brokerage service further comprising a step of communicating with the relevant auction servers to alter the desired price according to the user's instruction when the commodity has found no buyer at all of said auction sites where the commodity had been registered by the date specified by the user. The practice of changing an offer price such as by reducing the offer price when there have been no offers at a given price was well known in the art of auctions and in the basic selling art in cases when an item was confirmed to have been legitimately exposed to prospective buyers ("where the commodity had been registered (in an auction) by the date specified by the user"). Therefore, it would have been obvious to an ordinary practitioner at the time of

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Applicant's invention to have combined the disclosures of Huberman with the disclosures of Koopersmith and with the incorporation of the above mentioned well known practices for the purpose of communicating with the relevant auction servers to alter the desired price according to the user's instruction when the commodity has found no buyer at all of said auction sites where the commodity had been registered by the date specified by the user, motivated by an opportunity to establish better prices for the sale of commodities through a more efficient auction process through electronically networked, highly automated, brokered auctions (Huberman, Col. 2, ll. 50-51, 55-56).

**Re. Claim 4**, Huberman discloses a method for auction brokerage service further comprising a step of communicating with relevant auction servers to notify other auction sites of cancellation of registration of the corresponding commodity, in case of termination of the auction when the commodity has found the buyer at any of said auction sites. Removing an item from being offered for sale after a sale has been made is a logical step to take, and was a well established practice in the art at the time of Applicant's invention. Therefore, it would have been obvious to an ordinary practitioner at the time of Applicant's invention to have combined the disclosures of Huberman with the disclosures of Koopersmith and with the incorporation of the above mentioned well known practices for the purpose of communicating with relevant auction servers to notify other auction sites of cancellation of registration of the corresponding commodity, in case of termination of the auction when the commodity has found the buyer at any of said auction sites, motivated by an opportunity to establish better prices for the sale of commodities through a more efficient auction process through electronically networked, highly automated, brokered auctions (Huberman, Col. 2, ll. 50-51, 55-56).

**8. Claims 5-10 are rejected** under 35 U.S.C. 103(a) as being unpatentable over Huberman.

**Re. Claims 5 & 8**, Huberman does not explicitly disclose the detailed specifics of a method and related means for execution in a computer system executed by a machine

residing between an auction user and auction organizers to perform brokerage operation for an auction, said computer system having a computing environment at the side of the auction user, a plurality of computing environments at the side of the auction organizers, and a computing environment at the broker side, the method comprising steps of:

- (a) receiving information about an auctioned commodity and at least one specified auction organizer from the computing environment (at the side of the auction user)
- (b) sending the information about the auctioned commodity to the specified auction organizers;
- (c) monitoring trading status of said auctioned commodity by communicating with the computing environment at the side of the specified auction organizers;
- (d) notifying the computing environment at other auction organizers of the highest bidding price among all bidding prices to unify bidding prices at the side of said auction organizers into the highest price if any buyer has been found for said auctioned commodity at any of said auction organizers; and
- (e) taking an action in accordance with conditions specified by the auction user if no buyer has been found for said auctioned commodity at all of said auction organizers.

However, at the time of Applicant's invention,

- (1) Use of third party service providers or brokers performed through computer automated methods and means was well known (Huberman, Col. 1, ll. 35-40).
- (2) Offering of commodities on multiple parallel auction services was well known (See the rejection of claim 1).
- (3) The various tasks to be performed by a third party service provider for a customer within the scope of the assignment, including communications tasks and other steps, was implicit and obvious to the performance of a third party service.

In this case, an ordinary practitioner of the art at the time of Applicant's invention would have found it obvious to combine the disclosures of Huberman with well known practices for the purpose of providing the service of an auction brokerage operation for a user customer, motivated by an opportunity to establish better prices for the sale of

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commodities through a more efficient auction process through electronically networked, highly automated, brokered auctions (Huberman, Col. 2, ll. 50-51, 55-56).

**Re. Claims 6 & 9,** Huberman does not explicitly disclose the detailed specifics of a method and means for execution comprising a step of notifying the computing environment at the side of said auction organizers of alternation of the desired price according to the instruction of the auction user if no buyer has been found for said auctioned commodity at all of said auction organizers by the date specified by the auction user. However, it would have been obvious to an ordinary practitioner at the time of Applicant's invention to have notify the computing environment at the side of said auction organizers of alternation of the desired price according to the instruction of the auction user if no buyer has been found for said auctioned commodity at all of said auction organizers by the date specified by the auction user for the reasons stated in the rejection of claim 3.

**Re. Claims 7 & 10,** Huberman does not explicitly disclose the detailed specifics of a method comprising a step of notifying the computing environment at the side of the other auction organizers where said auctioned commodity is registered of cancellation of registration when any buyer has been found at any of said auction organizers and the auction is terminated. However, it would have been obvious to an ordinary practitioner at the time of Applicant's invention to have notify the computing environment at the side of said auction organizers of cancellation of registration when any buyer has been found at any of said auction organizers and the auction is terminated for the reasons stated in the rejection of claim 4.

### ***Conclusion***

9. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Siegfried Chencinski whose telephone number is (571)272-6792. The Examiner can normally be reached Monday through Friday, 9am to 6pm.

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If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Hyung S. Souh, can be reached on (571) 272-6799.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any response to this action should be mailed to:

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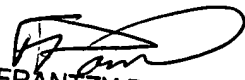
or (571)273-8300 [Official communications; including After Final communications labeled "Box AF"]

(571) 273-6792 [Informal/Draft communications, labeled "PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to the address found on the above USPTO web site in Alexandria, VA.

SEC

June 16, 2006

  
FRANTZY POINVIL  
PRIMARY EXAMINER  
Au 3628